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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/727,443	Applicant(s) BARNARD ET AL.	
	Examiner Susanna M. Diaz	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,11,18,20,23 and 27-30 is/are pending in the application.
 4a) Of the above claim(s) 18,23 and 27-30 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 10,11 and 20 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed November 7, 2005.

Claims 10, 11, and 20 have been amended.

Claims 18, 23, and 27-30 stand as withdrawn. (Please cancel claims 18, 23, and 27-30 in response to this Office action.)

Claims 10, 11, and 20 are presented for examination.

2. The objection to the declaration is withdrawn in response to Applicant's submission of a corrected declaration.

The previous rejections under 35 U.S.C. § 112, 2nd paragraph are withdrawn in response to Applicant's claim amendments.

Response to Arguments

3. Applicant's arguments filed November 7, 2005 have been fully considered but they are not persuasive.

Applicant argues the claims, as amended, which are addressed in the revised art rejection below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gundewar et al. (U.S. Patent No. 6,381,610).

Gundewar discloses a system for using an on-line data gathering tool for evaluating a potential client system and for adapting an application to the requirements of each of many potential clients operable by third party providers and for monitoring and assuring the quality of services provided by said service providers, comprising:

[Claim 10] a server (Fig. 1, #12);

a storage device connected to said server (Fig. 1, #20, 22, 24, 26, 28, 29);

a plurality of terminals, said terminals including enterprise terminals and provider terminals (Fig. 1, #14, 16, 18);

a communication link interconnecting said server and said terminals (Fig. 1, #21, 30);

said server (1) maintaining on said storage device, for each of a plurality of customers, a database of templates describing procedures for assessing, preparing developing, deploying and supporting each of said applications, and (2) serving said templates to members of enterprise teams and said third party provider teams operating said terminals (Fig. 1; col. 4, lines 15-51; col. 6, lines 60-64 -- Users in charge of completing or planning project planning tasks can access the necessary templates that guide them through company or industry standards "without requiring the user to be familiar with such standards," thereby implying that a third party (i.e., someone external

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to each user) programs the templates in light of company or industry standards. Also, various entities may interface to one another via the server); and

said server responsive to member input to said templates at said terminals for coordinating, recording and tracking team activity with respect to said application during assessment, preparation, development, deployment and support stages adapting an application to the requirements of a selected one of said potential clients (col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- A project may be tracked from the planning through the completion stages and the related activities may be documented using various templates);

[Claim 11] said terminals being web-enabled terminals and said server further serving to said terminals a panel for task creation by said enterprise team and task use by said enterprise and provider teams (col. 3, lines 16-17; col. 4, lines 15-51; col. 6, lines 60-64 -- Users in charge of completing or planning project planning tasks can access the necessary templates that guide them through company or industry standards "without requiring the user to be familiar with such standards," thereby implying that a third party (i.e., someone external to each user) programs the templates in light of company or industry standards).

While Gundewar discloses that the stored and created templates are used for project management applications, Gundewar fails to expressly teach that the specific type of project management applications include a general procurement and accounts payable application. However, these limitations merely recite various intended uses of

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the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art. Furthermore, the Examiner submits that general procurement and accounts payable applications are commonly utilized as part of project management planning. For example, many projects are limited by constraints related to costs, including accounts payable, and the ability to obtain needed resources, i.e., general procurement. In order to more fully understand the limitations imposed on a project as a whole and the likelihood of achieving project goals, a more comprehensive analysis of all factors affecting the project is required. Since Gundewar is already directed toward project management and therefore suggests the incorporation of factors related to project management, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar to include a general procurement and accounts payable application as part of its project management templates system in order to assist users involved with the planning of a particular project in more fully

understanding the limitations imposed on a project as a whole and the likelihood of achieving project goals, thereby yielding a more comprehensive analysis of all factors affecting the project.

Claim 10 has been amended to recite more examples of mere intended use (e.g., “for evaluating a legacy general procurement and accounts payable application of a client of an enterprise and for adapting through presales, assessment, preparation, development, deployment, and support stages a general procurement and accounts payable application to the requirements of each of a plurality of clients of said enterprise and for monitoring and assuring the quality of services provided by a service provider to said clients,” “for presentation to teams of enterprise users and provider users at respective user interfaces of said enterprise terminals and said provider terminals,” “for collecting support stage data from users of said provider terminals during said support stage,” “for presenting at user interfaces of enterprise and provider terminals templates for tracking provider team activities with respect to said general procurement and accounts payable application for a client,” etc.) which do not affect the recited structure or functionality. Therefore, the intended use fails to distinguish the claimed invention over Gundewar (for the reasons addressed in the discussion of intended use above).

Also, claim 10 has been amended to recite various types of playbook buttons and various groupings of listings of tasks. Again, these buttons and tasks are never correlated to any expressly recited steps that require the details of these specific types of buttons and tasks. Consequently, these specific types of buttons and tasks are non-

functional, descriptive material and, therefore, do not patentably distinguish the claimed invention over Gundewar.

The Examiner would like to note, however, that if the examples of intended use are positively recited as steps that are actually performed and the non-functional data is actively recited as being used to perform positively recited steps that require use of the particular types of buttons and tasks, then claims 10 and 11 would likely become allowable over the prior art of record. (A final decision would be made upon review of any future claim language as well as an updated search.)

Gundewar discloses a system for using an on-line data gathering tool for adapting a general procurement and accounts payable application to the requirements of each of many potential customers operable by third party service provider team members and for enterprise team members to monitor and assure the quality of services provided by said third party service providers to each said potential customer and for providing a repeatable process for training, managing, certifying and educating a service provider to operate an application on behalf of a customer of an enterprise, comprising:

[Claim 20] a first server (Fig. 1, #12);

a storage device connected to said server (Fig. 1, #20, 22, 24, 26, 28, 29);

a plurality of team terminals, said terminals including enterprise terminals and provider terminals, for interfacing to said members of said enterprise team and to

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members of said third party service providers (Fig. 1, #14, 16, 18 -- Various entities may interface to one another via the server);

said first server for (1) maintaining a database on said storage device of templates describing procedures for executing said application, and (2) serving said templates to team members operating said terminals; said team members, responsive to said templates, coordinating, recording and tracking enterprise team activities with respect to said service provider (Fig. 1; col. 4, lines 15-51; col. 5, line 42 through col. 8, line 11 -- Users in charge of completing or planning project planning tasks can access the necessary templates that guide them through company or industry standards "without requiring the user to be familiar with such standards," thereby implying that a third party (i.e., someone external to each user) programs the templates in light of company or industry standards).

While Gundewar discloses that the stored and created templates are used for project management applications, Gundewar fails to expressly teach that the specific type of project management applications include a general procurement and accounts payable application. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as

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compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art. Furthermore, the Examiner submits that general procurement and accounts payable applications are commonly utilized as part of project management planning. For example, many projects are limited by constraints related to costs, including accounts payable, and the ability to obtain needed resources, i.e., general procurement. In order to more fully understand the limitations imposed on a project as a whole and the likelihood of achieving project goals, a more comprehensive analysis of all factors affecting the project is required. Since Gundewar is already directed toward project management and therefore suggests the incorporation of factors related to project management, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar to include a general procurement and accounts payable application as part of its project management templates system in order to assist users involved with the planning of a particular project in more fully understanding the limitations imposed on a project as a whole and the likelihood of achieving project goals, thereby yielding a more comprehensive analysis of all factors affecting the project.

While Gundewar teaches that all communications may be conducted through the Internet (col. 3, lines 16-17), Gundewar does not expressly disclose use of a second

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server interfacing through a firewall to an operational accounting system and a communication link interconnecting said first and second servers and said terminals, wherein said second server is for serving operational accounting data to said team terminals. However, the Examiner submits that these limitations are directed toward setting up a firewall between the central server and all clients in communication with the server, which Examiner further submits is old and well-known in the art (including in the art of accounting). Firewalls are used to better control remote access to secure data, thereby protecting the integrity of the data, which is especially important with sensitive information such as accounting data. Since the modified version of Gundewar addresses an accounts payable application (as discussed above) and Gundewar's invention is already disclosed as implemented on the Internet, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to further modify Gundewar to include a second server interfacing through a firewall to an operational accounting system and a communication link interconnecting said first and second servers and said terminals, wherein said second server is for serving operational accounting data to said team terminals in order to better control remote access to secure data, thereby protecting the integrity of the data, which is especially important with sensitive information such as the accounting data already shown as useful in the modified version of Gundewar.

Claim 20 has been amended to recite more examples of mere intended use (e.g., "for task creation at a user interface of said enterprise terminals," "for task use at said enterprise terminals and said provider terminals," "for collecting support data," and "for

tracking activities of said third party service provider team members in managing said resulting general procurement and accounts payable application for said selected customer”), which do not affect the recited structure or functionality. Therefore, the intended use fails to distinguish the claimed invention over Gundewar (for the reasons addressed in the discussion of intended use above).

Also, claim 20 has been amended to recite various types of playbook buttons. Again, these buttons are never correlated to any expressly recited steps that require the details of these specific types of buttons. Consequently, these specific types of buttons are non-functional, descriptive material and, therefore, do not patentably distinguish the claimed invention over Gundewar.

The Examiner would like to note, however, that if the examples of intended use are positively recited as steps that are actually performed and the non-functional data is actively recited as being used to perform positively recited steps that require use of the particular types of buttons recited as well as other tasks (such as the tasks referred to in claim 10), then claim 20 would likely become allowable over the prior art of record. (A final decision would be made upon review of any future claim language as well as an updated search.)

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 10, 11, and 20 are rejected on the ground of nonstatutory obviousness-

type double patenting as being unpatentable over claims 1-10 of U.S. Patent No.

6,684,191. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the principle difference between the two sets of claims

is the use of the recited templates. However, both the instant application and U.S.

Patent No. 6,684,191 utilize the recited templates for various types of old and well-

known consulting functions. Therefore, the Examiner submits that it would have been

obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize the

templates of the patent for the specific types of consulting applications recited in the

instant application in order to make these templates more versatile and useful for a

wider range of consulting functions, thereby making this template software more

marketable.

8. Claims 10, 11, and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,714,915. Although the conflicting claims are not identical, they are not patentably distinct from each other because the principle difference between the two sets of claims is the use of the recited templates. However, both the instant application and U.S. Patent No. 6,714,915 utilize the recited templates for various types of old and well-known consulting functions. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize the templates of the patent for the specific types of consulting applications recited in the instant application in order to make these templates more versatile and useful for a wider range of consulting functions, thereby making this template software more marketable.

9. Claims 10, 11, and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,738,746. Although the conflicting claims are not identical, they are not patentably distinct from each other because the principle difference between the two sets of claims is the use of the recited templates. However, both the instant application and U.S. Patent No. 6,738,746 utilize the recited templates for various types of old and well-known consulting functions. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize the templates of the patent for the specific types of consulting applications recited in the

instant application in order to make these templates more versatile and useful for a wider range of consulting functions, thereby making this template software more marketable.

10. Claims 10, 11, and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,687,677. Although the conflicting claims are not identical, they are not patentably distinct from each other because the principle difference between the two sets of claims is the use of the recited templates. However, both the instant application and U.S. Patent No. 6,687,677 utilize the recited templates for various types of old and well-known consulting functions. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize the templates of the patent for the specific types of consulting applications recited in the instant application in order to make these templates more versatile and useful for a wider range of consulting functions, thereby making this template software more marketable.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. This application contains claims 18, 23, and 27-30 drawn to a non-elected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

January 23, 2006